



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------------|------------------------|
| 10/599,445 | 11/21/2006 | Katsunobu Kitami | 1382-004 | 9062 |
| 22208 | 7590 | 12/11/2009 | | |
| The Marbury Law Group, PLLC 11800 SUNRISE VALLEY DRIVE SUITE 1000 RESTON, VA 20191 | | | EXAMINER SAVAGE, MATTHEW O | |
| | | | ART UNIT 1797 | PAPER NUMBER |
| | | | MAIL DATE 12/11/2009 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/599,445

Applicant(s)

KITAMI ET AL.

Examiner

Matthew O. Savage

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to claim 7, alloys other than palladium alloys are considered new matter. It is suggested that "an alloy thereof" be changed to --a palladium alloy--.

With respect to claim 10, the concept of "spherical catalyst supports which are carried with the anion exchange resin" is considered new matter. It is suggested that "catalyst supports which are carried with the anion exchange resin" be changed to – anion exchange resins--.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Morita et al.

With respect to claim 1, Morita et al disclose an ultrapure water production plant (see FIG. 2) producing ultrapure water including an ultraviolet oxidation equipment 21

and a catalyst mixed tower 29 (see FIG. 9a) located downstream of the ultraviolet oxidation equipment 21 and having catalyst supports each of which has a catalyst carried on a support, the catalyst mixed tower also having anion exchange resins for ion exchange (see lines 38-47 of col. 7).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morita et al in view of Kazuki et al.

With respect to claim 2, Morita et al disclose de-mineralizing equipment 22 located downstream of the catalyst mixed tower but fail to specify a membrane degasser located in the downstream of the catalyst mixed tower. Kazuki et al disclose an analogous system that includes a degasser 15 located downstream of a catalyst unit 14 and teaches that such an arrangement removes gases produced by the UV radiation unit and catalyst unit. It would have been obvious to have modified the system of Morita et al so as to have included a degasser as suggested by Kazuki et al in order to remove gases evolved by the UV radiation unit and the catalyst unit.

As to claim 3, Morita et al disclose the demineralization equipment 22 as being an ion exchange resin tower including a mixed bed in which the anion exchange resins and cation exchange resins are mixed (see lines 41-42 of col. 10).

With respect to claims 4 and 5, Morita et al disclose a ratio of the catalyst supports to the anion exchange resins as being between 3% and 20% by weight and 8% and 13% by weight (e.g., .1-10%, see lines 14-17 of col. 7).

Concerning claim 6, Morita et al discloses a palladium catalyst that is capable of decomposing hydrogen peroxide (see lines 61-62 of col. 6).

As to claim 7, Morita et al disclose the catalyst as being selected from palladium (see lines 61-62 of col. 6).

As to claims 8 and 9, Morita et al disclose the support as being an ion exchange resin in the form of an anion exchange resin (see lines 17-21 of col. 7).

Concerning claim 10, Morita et al disclose that the supports can be in any form including granules (see from line 66 of col. 6 to line 1 of col. 7) and discloses anion exchange resins that are typically in the form of beads which are spherical (e.g., the Dowex 550A anion exchange resin mentioned on line 59 of col. 11).

Regarding claim 11, Morita et al disclose anion exchange resins that are strong base anion exchange resins (e.g., Dowex 550A, see line 59 of col. 11).

As to claim 12, Morita disclose a substrate of the anion exchange resins as being selected from styrene origins (e.g., Dowex 550A).

Concerning claim 13, Morita disclose the substrate of the anion exchange resins as having a structure which is selected from a gel type (e.g., Dowex 550A).

Regarding claim 14, Morita et al disclose the catalyst mixed tower as holding the anion exchange resins and the catalyst supports in a mixed state (see lines 45-47 of col. 7).

As to claim 15, Morita et al disclose the catalyst mixed tower as holding the anion exchange resins and the catalyst supports separately (e.g., in a laminate of layers, see line 47 of col. 7 or elements 22 and 49 in FIG. 9b).

Concerning claim 16, Morita et al disclose the catalyst mixed tower (see FIG. 9b) as being a layered bed type holding a catalyst support layer 49 located on an inflow side of the liquid to be processed and an anion exchange resin layer 22 located on an outflow side of the liquid.

As to claim 17, Morita et al disclose the catalyst mixed tower as further including cation exchange resins (see lines 45-47 of col. 7).

With respect to claim 18, Morita et al and Kazuki et al fail to mention a velocity of 10 to 200 hr⁻¹, however, such a modification would have been obvious in order to optimize the degree of purification of the water for a particular application.

Concerning claim 19, Morita et al disclose a direction of the liquid to be processed as being set to downflow (see FIGS 9a and 9b).

With respect to claim 20, Morita et al and Kazuki et al fail to specify the primary pure water as having a resistivity equal to or greater than 10 MΩcm, a dissolved oxygen concentration of 0 to 1000 µg / L, an organic compounds concentration of 0 to 20 µg/L, and a metal concentration of 0 to 1 µg/L, however, such a modification would have been obvious in order to optimize the efficiency of the ultrapure water production plant for a particular application.

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew O. Savage whose telephone number is (571) 272-1146. The examiner can normally be reached on Monday-Friday, 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on (571) 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew O Savage/
Primary Examiner
Art Unit 1797

mos